



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/000,130 | 12/04/2001 | Hisakazu Hojo | 011637 | 8475 |

23850 7590 11/19/2003

ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP
1725 K STREET, NW
SUITE 1000
WASHINGTON, DC 20006

EXAMINER

PRATT, HELEN F

ART UNIT

PAPER NUMBER

1761

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

10/000,130

Applicant(s)

HOJO ET AL.

Examiner

Helen F. Pratt

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1- 5, 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buddemeyer et al. (6,248,376) in view of Buddemeyer et al. (4,214,996) and Sawhill (5,643,622).

Buddemeyer et al. disclose a process of making calcium enriched compositions as in claim 1 by combining water, calcium hydroxide and citric acid, and then adding a source of phosphate ions (col. 15, lines 44-65 and col. 16, lines 1-23 and col. 2, lines 6-15). Claim 1 differs from the reference in the addition of an alkali metal phosphate or some form of it at the very end of the process. However, Buddemeyer et al. '376 disclose that the phosphate ions from acids is a preferred method, but that other sources of phosphate ions can be used (col. 2, lines 6-15). Buddemeyer et al. '996 disclose that a calcium compound can be made by adding a source of alkali metal phosphate to water, and a cation source and adding the acid last (col. 4, lines 48-65). Sawhill discloses a process of making a feed supplement containing calcium carbonate by adding a gelling agent to whey, and calcium oxide or hydroxide and phosphoric acid and then at the end an alkali metal salt such as magnesium oxide (col. 17, lines 25-55). Therefore, it would have been obvious to use alkali metal at the end of the process with

the other ingredients because the other claimed ingredients have been shown and the alkali metal serves to solidify the mixture.

Claim 2 further requires that the addition of phosphoric acid and an alkali metal is selected from methods d or e. However, the various methods are seen to be obvious variations. If they are argued to be distinct methods, then the claims should be restricted to take this into account. In addition, Buddemeyer '996 disclose the addition of phosphoric acid in an admixture and discloses the addition of potassium phosphate (col. 4, lines 1-65). Nothing is seen at this time that there is a patentable distinction in the products made in the order of addition of the chemicals. Therefore, it would have been obvious to add the various chemicals at the best times to achieve the required product.

Claim 3 requires various ratios of ingredients. However, as it is known how to make the claimed composition, it would have been obvious to vary the amounts to achieve various compounds depending on the reactants. Therefore, it would have been obvious to vary the amounts to achieve particular compounds with the required characteristics.

Claim 4 further requires the use of an emulsification stabilizer and that the product is dispersed using a grinding machine or a dispersing machine and claim 5 particular kinds of grinding machines or dispersing machines. Sawhill discloses the use of gelling agents which are known emulsifiers (abstract and col. 6, lines 25-30). Buddemeyer et al. '996 discloses that the composition can be spray dried (col. 5, lines 1-4). This is considered to be a dispersing machine,

because the compound is dispersed into the heated air as in claim 4 and an emulsifying-dispersing machine in claim 5. A spray drier is considered to be an emulsifying machine because the mixture is mixed in a spray drier thus emulsifying it. In addition, the particular apparatus is not given weight in a process claim if the particular function of the claimed apparatus has been shown. Therefore, it would have been obvious to add gelling agents as emulsification stabilizers in the claimed composition and to disperse the composition.

Claim 7 is also a product by process claim. The fact that the procedures of the reference are different than that of applicant is not a sufficient reason for allowing the product-by-process claims since the patentability of such claims is based upon the product formed and not the method by which it was produced. See *In re Thorpe* 227 USPQ 964. The burden is upon applicant to submit objective evidence to support their position as to the product-by-process claims. See *Ex parte Jungfer* 18 USPQ 2D 1796. Therefore, it would have been obvious to make a food composition as shown by the above combined references.

ALLOWABLE SUBJECT MATTER

Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen F. Pratt whose telephone number is 703-308-1978. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

Application/Control Number: 10/000,130
Art Unit: 1761

Page 5

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Milton Cano, can be reached on (703) 308-3959. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

Hp 11-14-03


HELEN PRATT
PRIMARY EXAMINER